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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/656,274
Filing Date: September 08, 2003
Appellant: KATO, YOSHIKAZU

Mr. Bradley D. Lytle and Mr. James Love
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

In response to the reply brief filed 15 October 2010, a supplemental Examiner's Answer is set forth below.

Art Unit: 3621

Acknowledgements

1. Appellant's reply brief filed 15 October 2010 ("2010 Reply Brief") is acknowledged.
2. The 2010 Reply Brief is in response to the Examiner's Answer mailed 18 August 2010, Paper No. 20100121 ("August 2010 Examiner's Answer").
3. The August 2010 Examiner's Answer is in response to the Appeal Brief filed 11 November 2009 ("2009 Appeal Brief").
4. The 2009 Appeal Brief is in response to the Examiner's Final Office Action mailed 08 August 2009, Paper No. 20090723 ("2009 Final Office Action").
5. To assist the USPTO's Board of Patent Appeal and Interferences ("Board"), to clarify what is and what is not a "New Grounds of Rejection," and in an effort to keep this response short, the Examiner will address selected arguments from the 2010 Reply Brief.
6. Because of the issues discussed in the "Official Notice Arguments" section¹ of the August 2010 Examiner's Answer, because Appellant still desires to challenge the merits of the officially noticed statements,² and because of the frequency of Appellant's arguments in other ex parte examination applications, the Examiner respectfully requests that the Board's decision addressing the 'Official Notice Arguments' be precedential.
7. Appellant may file another reply brief in compliance with 37 C.F.R. § 41.41 within two months of the date of mailing of this supplemental examiner's answer. Extensions of time under 37 CFR 1.136(a) are not applicable to this two month time period. See 37 C.F.R. § 41.43(b)-(c).
8. This Supplemental Examiner's Answer is assigned Paper No. 20110101.

¹ See August 2010 Examiner's Answer at pp. 46-52.

² See 2010 Reply Brief at p 13.

Art Unit: 3621

Clarification on New Grounds of Rejection

9. To be clear, there is only one new ground of rejection in this appeal. The single “New Grounds of Rejection” is a 35 U.S.C. § 112 2nd paragraph rejection **on claims 7-9**, (i.e. the Hybrid claim rejection which begins on page 12 of the August 2010 Examiner’s Answer).

10. The title (i.e. “New Grounds of Rejection”) on pages 3 and 7 of the August 2010 Examiner’s Answer is hereby removed. (The 35 U.S.C. § 112 2nd paragraph rejections found on page 3 of the August 2010 Examiner’s Answer were present in the 2009 Final Office Action).

11. Although the new grounds of rejection in August 2010 Examiner’s Answer stated on page 12 that “[c]laims 7 and 8 are alternatively rejected under 35 U.S.C. § 112, 2nd paragraph,” the statement of rejection should have said claims 7-9. Appellant does not appear to challenge this issue. However, the new, alternative grounds of rejection of claims 7-9 stands or falls with the decision on claim 7 alone.

Alleged “Subjective Findings of Fact”

12. Appellant’s states in §III A. of the 2010 Reply Brief:

Appellants note that the Examiner’s Findings of Fact (EFF) are subjective findings based on the Examiner’s interpretation of the prosecution history. As such, Appellants provide no comments regarding the findings of fact and note that this should not be construed as an agreement by Appellants as to any of the EFF.

2010 Reply Brief, page 2.

13. First, the Examiner’s Findings of Fact are not “subjective” as alleged. The Findings of Fact are just that—facts. If Appellant disagrees with a specific finding of fact, Appellant is hereby requested to specifically point out the alleged incorrect Finding of Fact **and** provide facts with reasoning to support his position.

Art Unit: 3621

14. The Examiner has again reviewed the finding of facts and can not locate anything subjective. Instead, all of the Examiner's Findings of Fact are based upon an **objective** review of the prosecution history. Again, in order to have meaningful administrative or judicial review, if Appellant believes a particular finding of fact is in error, Appellant is requested to expressly point out the alleged incorrect Finding of Fact **and** provide facts with reasoning to support his position.

Corresponding Structure of the Means Plus Function Elements

15. Appellant's state on page 9, lines 4-6, of the 2010 Reply Brief that "[n]owhere does the Appeal Brief describe the 'storage means' as corresponding to the storage unit 58 in combination with content data 112." Appellant is factually incorrect. The 2009 Appeal brief in the "Summary of Claimed Subject Matter" **expressly states** on page 2, footnote 3 "Figure 4, items 58 **and 112** and page 13, lines 6-9" (emphasis added by the Examiner).

16. Appellant appears to argue in 2010 Reply Brief that item **112** was cited in the 2009 Appeal Brief because it refers to the "storing" function. Appellant's argument is not persuasive for at least three (3) reasons

- a. There is no requirement to point out the claimed function in the specification. Instead, 37 C.F.R. § 47.67(c)(v) requires the appellant to point the claimed structure.
- b. Caselaw is clear that it's the **structure** that must be pointed out, **not** the claimed function.
- c. Appellants have made express statements in the 2009 Appeal Brief that corresponding structure is in the 'Summary of Claimed Subject Matter.'

Art Unit: 3621

17. These three (3) reasons will next be discussed:

18. First, the Examiner notes that when filing an appeal brief, an appellant's brief must address the corresponding structure—not the function in the specification:

37 C.F.R. § 47.67(c)(v) **Summary of claimed subject matter.** A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by column and line number, and to the drawing(s), if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified **and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth** with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

See 37 C.F.R. § 47.67 (c) [Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004].

19. Based upon 37 C.F.R. § 47.67 (c)(v) and the other objective evidence of record as noted above, its unclear as to how Appellant can now argue that the cited portion in the “Summary of Claimed Subject Matter” as found in the 2009 Appeal Brief is anything other than Appellant's attempt at pointing out the corresponding structure.

20. Second, the Examiner notes that the law is clear that Appellant must point to the **corresponding structure** in the specification—not the function in the specification. In other words, there is no requirement that an appellant point to the function in the specification. In fact, it is a clear error to determine the function from anything other than the claim itself. “The function of a means-plus-function limitation, however, must come from the claim language itself.” *Micro Chem., Inc. v. Great Plains Chem. Co.*, 194 F.3d 1250, 1258, 52 USPQ2d 1258, 1263 (Fed. Cir. 1999). “When construing the functional statement in a means-plus-function

Art Unit: 3621

limitation, we must take great care not to impermissibly limit the function by adopting a function different from that explicitly recited in the claim.” *Generation II Orthotics Inc. v. Medical Technology Inc.*, 59 USPQ2d 1919, 1926 (Fed. Cir. 2001).³ Thus it is unclear why Appellant would point out the function in the specification.

21. Third, Appellant’s make repeated assertions that the “Summary of Claimed Subject Matter” discloses the corresponding **structure** to the means plus function elements:

In the present case, as is noted above in section V, the structure of the means plus function elements of Claim 1 is clearly found in the disclosure as originally filed. [Emphasis added.]

2009 Appeal Brief at 6.

Appellants, however, have already stated on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function. **Specifically, in the “SUMMARY OF THE CLAIMED SUBJECT MATTER” section of Appellants’ appeal brief** (which the Examiner had no objection to on item (5) page 2 of the Examiner’s Answer), **Appellants have clearly provided examples of the corresponding structure**, material, or acts that are set forth in the written description of the specification that perform the claimed function. [Emphasis added.]

2010 Reply Brief at 8.

22. While Appellant may have **subjectively** intended to recite the claimed function in footnote 3 of the 2009 Appeal Brief, the **objective** evidence of record (as noted above) indicates that element **112** as recited in footnote 3 of the 2009 Appeal Brief was recited to show the corresponding structure—not function. Appellant is reminded that “what the patentee

³ “Under § 112, 6, a court may not import functional limitations that are not recited in the claim, or structural limitations from the written description that are unnecessary to perform the claimed function.” *Omega Engineering Inc. v. Raytek Corp.*, 334 F.3d 1314, 67 USPQ2d 1321, 1332 (Fed. Cir. 2003); *Wenger Mfg., Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1233, 57 USPQ2d 1679, 1684 (Fed. Cir. 2001).

Art Unit: 3621

subjectively intended his claims to mean is largely irrelevant to the claim's objective meaning and scope." *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279 (Fed. Cir. 2000) citing *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 985-86, 34 USPQ2d 1321, 1334-35 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370, 134 L.Ed.2d 577, 38 USPQ2d 1461 (1996).

23. Based upon the three (3) objective reasons noted above, the Examiner concludes that footnote 3 in the 2009 Appeal Brief is an attempt by Appellant to assert the corresponding structure.

Appellant's Fourth Attempt at Corresponding Structure for Claims 1-3

24. Appellant next argues towards the end of page 9 in the 2010 Reply Brief that the specification discloses an algorithm on at least page 19, lines 13-21 of the specification. Appellant makes similar assertions on p. 10 the 2010 Reply Brief for the various means plus function phrases.

25. The Examiner finds that this is now Appellant's **Fourth** attempt at providing the corresponding structure for the various means plus function phrases. (See August 2010 Examiner's Answer pages 31-33 for a discussion of the Appellant's first three attempts at determining the corresponding structure for e.g. MP#2).

26. However because Appellant's fourth argument is not timely, Appellant's argument as to what algorithm constitutes the corresponding structure (as argued on pages 9 and 10 of the 2010 Reply Brief) will not be considered.

27. In the August 2010 Examiner's Answer, the Examiner expressly stated:

Art Unit: 3621

Arguments which Appellant Could Have Made

Arguments which Appellant could have made but chose not to make in the appeal brief have not been considered by the Examiner and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii). Moreover, **Appellants are given actual notice that any additional arguments that are raised for the first time in the Reply Brief are waived.** See *Optivus Tech., Inc. v. Ion Beam Applications S.A.*, 469 F.3d 978,989, 80 USPQ2d 1839, 1847-48 (Fed. Cir. 2006) (“[A]n issue not raised by an appellant in its opening brief., is waived.” (citation omitted) (internal quotation marks omitted)); *Ex parte Borden IV*, No. 2008-004312, slip op. (BPAI January 7, 2010) (informative); and *Ex parte Scholl*, No. 2007-3653, slip op. at 18-19 & n.13 (BPAI Mar. 13, 2008) (informative).

August 2010 Examiner’s Answer, p 25 (emphasis added)(footnotes omitted).

28. The Examiner has reviewed the 2009 Appeal Brief in its entirety and cannot locate in the 2009 Appeal Brief any discussion of the now alleged algorithm as now argued on pages 9-10 of the 2010 Reply Brief.

29. Moreover, Appellant does not argue any “good cause” as to why these alleged algorithms should be belatedly considered. As noted in informative opinion of *Ex parte Borden IV* cited above:

Belated arguments, if addressed, impose costs on the Agency (**specifically on the Examiner, the Technical Center Directors, and the Board**), which in turn impose costs on the public (most directly, on other applicants and appellants, who must wait longer for consideration of their applications and appeals; and indirectly, on the general public, which must wait longer for the benefits provided by a healthy and vigorous patent system). Properly interpreted, the Rules do not require the Board to take up a belated argument that has not been addressed by the Examiner, absent a showing of good cause.

Borden IV at 10-11(emphasis added).

30. A review of the 2009 Appeal Brief finds that Appellant cites in footnote 8 “Fig 8, S41 and page 17, lines 3-15.” However this footnote is used to support the method claim, **not product claims 1-3.**

Art Unit: 3621

31. For example, the 2009 Appeal Brief does **not** set forth any algorithm for the “managing means for managing ...” (i.e. MP#3). Similar citations are found in footnotes 9-12 on page 4 of the 2009 Appeal Brief. But again, these footnotes are used to support the method claim 4, not the algorithm for the corresponding structure in product claims 1-3.

32. In summary and for claims 1-3, because Appellant has discussed the alleged algorithms for the corresponding structure **for the first time** in the 2010 Reply Brief, because Appellant clearly had the opportunity to argue the alleged algorithm(s) in the 2009 Appeal Brief (yet chose not to argue the alleged algorithms), because Appellant has not made any averments as to ‘good cause,’ and because belated arguments impose costs on the Examiner, the Technology Center Directors, and the Board, **the Examiner has not and will not consider the belated arguments** (as found on page 9 and 10 of the 2010 Reply Brief) as to whether or not the specification clearly links and associates the claimed function to the corresponding structure.

Official Notice Arguments

33. In response to the Examiner’s “Official Notice Arguments” as found on pages 46-52 of the August 2010 Examiner’s Answer, Appellant argues:

Appellants respectfully submit that these assertions as well as any assertions relating to the jurisdiction of the Board of Patent Appeals and Interferences are not supported by applicable law.

2010 Reply Brief at 13.

34. Appellant’s arguments are not persuasive. As an initial matter, simply stating that an Examiner’s position is “are not supported by applicable law” without providing any guidance as to what constitutes this so called “applicable law” cannot be persuasive. In order to have

Art Unit: 3621

meaningful administrative or judicial review, it is incumbent upon a patent applicant to provide facts and reasoning as applied to any known authoritative court decisions, Board decisions, rules⁴ or manuals⁵.

35. To be especially clear, in this application, the Examiner's cited authority for his position is 37 C.F.R. § 1.111(b) as interpreted by the USPTO in the case of *In re Goodman*. Moreover, compliance with 37 C.F.R. § 1.111(b) is not optional, *Goodman* 3 USPQ2d at 1871 noting the examiners have no authority to waive 37 C.F.R. § 1.111(b).⁶

36. While the Examiner recognizes *Goodman* is not a binding authority, it is at the very least, a persuasive authority. If Appellant was aware of **any** authority (binding or persuasive) interpreting 37 C.F.R. § 1.111(b), Appellant should have brought this authority to the attention of the Examiner in his 2010 Reply Brief. Simply stating "applicable law" is not a substitute for a legal authority because it does not provide the Examiner a meaningful way of objectively analyzing Appellant's arguments. In other words, if Appellant believed that the Commissioner's interpretation of 37 C.F.R. § 1.111(b) as set forth in *Goodman* was contrary to law, Appellants had ample opportunity to cite specific cases and/or statutes (and apply them to the instant application) in his 2010 Reply Brief. However as is clearly evident from a review of the 2010

⁴ See e.g. title 37 in the Code of Federal Regulations (CFR).

⁵ See e.g. Manual of Patent Examining Procedure (MPEP).

⁶ See also: MPEP § 714.02 ¶3 "The requirements of 37 CFR 1.111(b) **must be complied with** by pointing out the specific distinctions believed to render the claims patentable over the references in presenting arguments in support of new claims and amendments; [Emphasis added]" See also: MPEP § 714.04 ¶1, "In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, **the claims should not be allowed**. See 37 CFR 1.111 and MPEP § 714.02. [Emphasis added.]"

Art Unit: 3621

Reply Brief, Appellant has elected not to do so. To be clear, the Examiner finds that Appellant has made no attempt whatsoever to challenge the Commissioner's interpretation of 37 C.F.R. § 1.111(b) as set forth in Goodman.

37. In summary, because 37 C.F.R. § 1.111(b) has the force and effect of law,⁷ because the Examiner has provided a persuasive authority indicating how the USPTO interprets 37 C.F.R. § 1.111(b) (i.e. In re Goodman), because Appellant has not challenged *Goodman's* interpretation of 37 C.F.R. § 1.111(b), and because Appellant's **only argument** challenging the application of Goodman to the instant application is that the Examiner's position is not supported by "applicable law," the Examiner concludes that the application of 37 C.F.R. § 1.111(b) and Goodman to the instant application is reasonable.

38. Because the application of 37 C.F.R. § 1.111(b) and Goodman to the instant application is reasonable and because Appellant still challenges the officially noticed statements, the Examiner's principle position (as set forth by the Examiner on pages 46-52 of the August 2010 Examiner's Answer) that the Board does not have subject matter jurisdiction of this appeal (because this application became abandoned as of midnight on 18 June 2009)⁸ must be sustained.

39. Because this application became abandoned on 18 June 2009, the Examiner respectfully requests the Board to remand this application to the Examiner with express instructions indicating this the application is abandoned.

⁷ "Patent Office Rules not contrary to the law have the force and effect of law." *Vandenberg v. Reynolds*, 46 CCPA 938, 268 F.2d 744, 122 USPQ 381, 382 (CCPA 1959).

⁸ "[T]he date of abandonment is after midnight of the date the period for reply actually expired. This is normally the end of the 3-month shortened statutory period." MPEP §711.04(a).

Art Unit: 3621

Appellant's Response to the New Grounds of Rejection, §112 2nd - Hybrid Claims

40. The only claims on appeal with a new grounds of rejection are claims 7-9. See

“Clarification on New Grounds of Rejection” section above.

41. For completeness, to support the initial 35 U.S.C. § 101 rejections of claims 7-9 as found in paragraphs nos. 5-9 in the 2009 Final Office Action, and for a “source” to support the broadest reasonable interpretation of various claimed "unit[s]" (as recited in claim 7), see the non-final office action mailed 18 March 2009:

27. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims. Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

dd. **“unit(6)(C) (software)** A software component that is not subdivided into other components. Note: The terms "module," "component," and "unit" are often used interchangeably or defined to be sub-elements of one another in different ways depending upon the context" [emphasis in original]. (IEEE 100 The Authoritative Dictionary of IEEE Standards Terms, 7th Edition, IEEE, Inc., New York, NY, Dec. 2000)

Non-Final Office Action, Paper No. 20090305, Page 13, Paragraphs 27 and 27 dd. (footnote omitted).

42. Before beginning a discussion of the new grounds of rejection (or Hybrid claim rejections), a simple review of the Examiner's position on claim 7 is set forth below:

1) It is the Examiner's **principle position** (as set forth in 2009 Final Office Action, ¶5 to ¶9) that claim 7-9 are rejected under 35 U.S.C. § 101 because the claim is directed to non-statutory subject matter.

Art Unit: 3621

2) In response to the 2009 Final Office Action, Appellant repeatedly argues (in the 2009 Appeal Brief) that the “using the information processing apparatus” is a positive limitation and therefore the claim complies with 35 U.S.C. § 101.

3) In response to Appellant’s arguments in the 2009 Appeal Brief that “using the information processing apparatus” is a positive limitation, the Examiner provides an **alternative position** (and new grounds of rejection in the August 2010 Examiner’s Answer) that claim 7 is a hybrid claim and therefore rejected under 35 U.S.C. § 112 2nd paragraph.

4) In response to the Hybrid claim rejection, Appellant now seems to argue in the 2010 Reply Brief at pp. 14-15, that phrase “using the information processing apparatus” is not a hybrid claim because the phrase should be interpreted as functional language in accordance with MPEP § 2173.05.

43. In light of the above timeline, the Examiner notes the following:

44. Appellant now argues in the 2010 Reply Brief beginning on p. 15, line 4:

The Examiner’s Answer again misconstrues the MPEP in indicating Claims 7 and 8 to be hybrid claims. In this regard, MPEP §2106 states:

A claimed invention may be a combination of devices that appear to be directed to a machine and one or more steps of the functions performed by the machine ... Note that an apparatus claim with process steps is not classified as a “hybrid” claim, instead, it is simply an apparatus claim including functional limitations. See, e.g., *R.A.C.C. Indus. v. Stun-Tech, Inc.*, 178 F.3d 1309 (Fed. Cir. 1998) (Emphasis added, citation omitted.)

One of ordinary skill in the art would clearly understand that Claim 7 is directed to an apparatus and that the phrase “a management unit implemented using a central processing unit” does not constitute a hybrid claim. Any assertions to the contrary are not supportable by applicable law. Accordingly, Appellants respectfully request that the new

Art Unit: 3621

grounds of rejection to Claims 7 and 8 under 35 U.S.C. §112, second paragraph be reversed. [Emphasis Appellant's.]

2010 Reply Brief, p 15.

45. First, Appellant's arguments in the 2010 Reply Brief (arguing that the phrase "using the information processing apparatus" is now functional language in accordance with MPEP §2106) is **completely opposite** of Appellant's position taken in the 2009 Appeal Brief where Appellant expressly stated the phrase is a positive limitation. See e.g. 2009 Appeal Brief at p. 7, where Appellant expressly states "Applicants note that the central processing unit recited in Claim 7 is clearly positively recited. Asserting that this feature is not positively recited is unsupportable by the facts in question."

46. Second, Appellant's statement that "[o]ne of ordinary skill in the art would clearly understand that Claim 7 is directed to an apparatus and that the phrase 'a management unit implemented using a central processing unit' does not constitute a hybrid claim" is conclusory. Based upon the preamble, the Examiner agrees that claim 7 is directed to an apparatus claim (or a machine claim).⁹ However simply stating "the phrase 'a management unit implemented using a central processing unit' does not constitute a hybrid claim" is not an argument. It's a conclusion. Finally, the Examiner notes that Appellant does not even attempt to apply his citation of MPEP §2106 to the facts in this application.

47. Third, Appellant's next sentence, "[a]ny assertions to the contrary are not supportable by applicable law" is also conclusory. The Examiner is again left to guess as to what constitutes

⁹ "Claims in apparatus form conventionally fall into the 35 U.S.C. §101 statutory category of a 'machine.'" Ex parte Donner, 53 USPQ2d 1699, 1701 (BPAI 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907).

Art Unit: 3621

this so called “applicable law.” As noted above, in order to have meaningful administrative or judicial review, it is incumbent upon a patent applicant to provide facts and reasoning as applied to any known authoritative court decisions, Board decisions, rules¹⁰, or even manuals¹¹. Simply stating “applicable law” is not a substitute for a legal authority because “applicable law” does not provide the Examiner a meaningful way of objectively analyzing Appellant’s arguments.

48. Forth, the Examiner finds that the 2010 Reply Brief fails to challenge the Examiner’s application of IPXL Holdings, L.L.C.v. Amazon.com, Inc., 430 F.3d 1377, 77 USPQ2d 1140 (Fed. Cir. 2005) to claim 7 of this application (and as set forth on pages 15-16 in the August 2010 Examiner’s Answer). Because Appellant fails to challenge the Examiner’s application of IPXL Holdings and because any subsequent challenge would be considered untimely (see *Ex parte Borden IV*, cited above), the Examiner simply concludes that IPXL Holdings is applicable to the instant application. Therefore (and as noted on page 15 of the August 2010 Examiner’s Answer), it is unclear whether infringement of claim 7 occurs when one creates the information processing apparatus having the claimed structure; or alternatively, whether infringement occurs when the management unit actual uses the central processing unit to implement the management unit.

49. In summary, the phrase “using the information processing apparatus” is either a positive limitation or it is not. It is the Examiner’s principle position that the phrase is **not** a positive recitation and claim 7 is therefore rejected under 35 U.S.C. § 101. Alternatively, it’s the Examiner’s secondary position that if the phrase “using the information processing apparatus” **is**

¹⁰ See e.g. title 37 in the Code of Federal Regulations (CFR).

¹¹ See e.g. Manual of Patent Examining Procedure (MPEP).

Art Unit: 3621

a positive limitation (as repeatedly argued by Appellant's in the 2009 Appeal Brief), then the claim must be rejected under 35 U.S.C. § 112 2nd paragraph because it's a hybrid claim.

50. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/JACOB C. COPPOLA/
Examiner, Art Unit 3621
11 January 2011

/ANDREW J. FISCHER/
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A Technology Center Director or designee has approved this Supplemental Examiner's answer by signing below:

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